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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/014,566 | 12/14/2001 | Kenji Yao | 111458 | 5994 |
| 25944 | 7590 | 03/29/2005 | EXAMINER | |
| OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320 | | | SERGENT, RABON A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1711 | |
| DATE MAILED: 03/29/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/014,566

Applicant(s)

YAO, KENJI

Examiner

Rabon Sergeant

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The election of species requirement has been withdrawn; accordingly, all claims have been examined on the merits.
2. Claims 7-9 and 12-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant has failed to specify the type of molecular weight (i.e.; weight average or number average). This information is considered necessary in order to adequately identify the functional material.
3. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, the definitions of Z and Z' are ambiguous. With respect to Z, it is unclear if Z is only a bond or if it contains the alkylene group, ester group, urethane group, amide group, or ether group. The relationship of the bond to these groups as it pertains to the definition of Z is not clear. With respect to Z', the language that Z' represents a reactive group capable of forming a group selected from the group consisting of an alkenyl group, ester group, urethane group, amide group, and ether group is confusing; the alkenyl group would seem to be the reactive group, as opposed to the group formed from the reactive group. Clarification is required. It is additionally unclear if the language, "another cyclic structure", refers to another cyclic structure corresponding to applicant's formulas (1) or (2). The examiner has interpreted the language defining Z as requiring at a minimum a compound having two cyclic structures bonded through Z.

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Secondly, the language that the integer represented by m is independent in respective repeating units is confusing, because it is unclear what repeating units are being referred to.

Thirdly, the language that a total number of the bond represented by Z is 1 or more is not clearly understood. The language is confusing with respect to the relationship between the bond represented by Z and the variable m .

Fourthly, within the next to last line of claim 10, it is unclear what limitation is being conveyed by "prescribed"; it is unclear what constitutes a prescribed mold or how a prescribed mold differs from a mold, *per se*.


Fifthly, the language within the second and last lines of claim 11 is confusing, because the language states that a coating is being coated. If applicant simply means that the coating is being applied, then the language should be clarified. If applicant intends that a coating be coated, then this also requires clarification.

Lastly, the language, "the functional material", of claim 14 lacks antecedent basis from claim 11. It appears that the dependency is incorrect.

4. While the prior art of record discloses macrocyclic esters, the prior art of record fails to disclose the bonding of a macrocyclic ester to another cyclic structure through applicant's claimed Z bond.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
March 16, 2005



RAISON SERGENT
PRIMARY EXAMINER